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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,441	09/16/2003	Finn Myhren	063779-5001	9826
9629 7590 12/02/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
BADJO, BARBARA P				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
12/02/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/662,441

**Applicant(s)**

MYHREN ET AL.

**Examiner**

Barbara P. Badio

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 56-64, 66, 68-75, 77, 79-82, 84 and 86-89 is/are pending in the application.
- 4a) Of the above claim(s) 62, 63, 68, 74, 75, 79 and 86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 56-61, 64, 66, 69-73, 77, 80-82, 84 and 87-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-849)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**First Office Action on the Merits**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 15, 2008 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Status of the Application***

3. Claims 56-64, 66, 68-75, 77, 79-82, 84 and 86-89 are pending in the present application. Claims 62, 63, 68, 74, 75, 79 and 86 stand withdrawn from further consideration as being drawn to a nonelected invention/species. Claims 56-61, 64, 66, 69-73, 77, 80-82, 84 and 87-89 will be examined according to MPEP § 803.02.

***Duplicate Claims***

4. Claims 60 and 72 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 56 and 57, respectively. When two claims in an application are

duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

### ***Claim Objections***

5. Claims 69, 80 and 87 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

The instant claims recite wherein the lipophilic moiety is unsaturated. The parent claims 56 and 57 are limited to c-9 monounsaturated lipophilic compounds and, thus, the instant claims do not further limit the subject matter of said claims.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 56, 58-61, 64, 66, 69-71 and 84 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 USC 112, first paragraph, have been described in *In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factors are (1) the nature of the invention, (2) the breadth of the claims, (3) the state of the prior art, (4) the predictability or unpredictability of the art, (5) the amount of guidance or direction presented, (6) the presence or absence of working examples, (7) the relative skill in the art and (8) the quantity of experimentation necessary. When the above factors are taken into consideration, the examiner's position is that one skilled in the art could not perform the invention commensurate in scope with the instant claim without undue experimentation.

The instant claims are drawn to a method for treating cancer in a patient by the administration of certain cytotoxic agents having a lipophilic moiety as defined by the instant invention.

Within the medical art, it is well known that there are several different mechanisms involved in the production of cancerous/tumor cells. It is also known in the art that there are a number of sites for tumor production and, thus, there are different forms of cancers/tumors including but not limited to embryonic tumor, prostate cancer, breast cancer, giant cell tumor of bone or tendon sheath, colon cancer, lung cancer and leukemia. The prior art also teaches that because of the diversity in the pathology of tumors, there are differences in treatment protocols. There is no example of a single product that is effective in treatment of cancers/tumors in general.

The present specification does not enable the skilled art in the art to which it pertains to use the claimed agents in treating cancer broadly. Because the present specification and the prior art lack guidance with regard to the treatment of all cancer cells with the claimed agents, an undue amount of experimentation would be required to practice the claimed invention.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

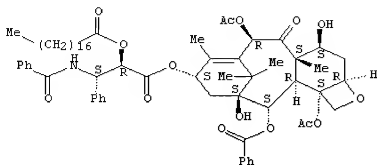
9. Claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claim is dependent on a cancelled claim and, thus, the metes and bound of the claimed invention is indefinite.

***Claim Rejections - 35 USC § 103***

10. Claims 56-61, 64, 66, 69, 70-73, 77, 80-82, 84 and 87-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayhew et al. (US 5,580,899).

Mayhew et al. teaches hydrophobic taxane derivatives such as



for use in treating cancers

including lung cancer (see the entire article, especially Table 5).

The instant claims differ from the reference by reciting the corresponding 9-monounsaturated fatty acid derivative. However, Mayhew teaches both saturated and unsaturated fatty acids (see col. 2, lines 1-48; col. 5, lines 47-49; especially col. 7, lines 17-26) and C-9 monounsaturated fatty acids such as oleic acid and elaidic acid are well known in the art (reference will be provided upon request). Therefore, it would have been obvious to the skilled artisan in the art at the time of the present invention to select any of the species of the genus taught by the reference, including that of the instant claims, because an ordinary artisan would have the reasonable expectation that any of the species of the genus would have similar properties and, thus, the same use as the genus as a whole.

### ***Telephone Inquiry***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara P. Badio whose telephone number is 571-272-0609. The examiner can normally be reached on M-F from 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on 571-272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Barbara P. Badio/  
Primary Examiner, Art Unit 1612